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LUC-443/Barclay 6-44-5-6-4

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Remarks

Claims 1-27 are pending in the above-identified application. Claims 1, 15, 26 and 27 were previously amended and claims 2-24 and 16-25 are original.

The Examiner rejected Claims 1, 2-3, 6-10, 15 and 19-21 under 35 U.S.C. 102(b) as being unpatentable over Okagaki et al (US Pub. No. 2002/0032876) in view of Ariyoshi (JP Patent No. 403248699) and further in view of BMW2001 (BWM Owner's Manual for Vehicle, Part No. 01410156416, Oct-2001, page 22, Steering Wheel with Multifunction buttons) further in view of Holloway (US Pub. No. 200410204192).

The Examiner rejected Claims 5, 11-12, 17, 23 and 24 under 35 U.S.C. 102(b) as being unpatentable over Okagaki et al (US Pub. No. 2002/0032876) in view of Ariyoshi (JP Patent No. 403248699) and further in view of BMW2001 (BWM Owner's Manual for Vehicle, Part No. 01410156416, 2000, page 22, Steering Wheel with Multifunction buttons) further in view of Holloway (US Pub. No. 2004/0204192) and further in view of Eiche (US Publication No. 2002/0137505).

The Examiner rejected Claims 13 and 24 under 35 U.S.C. 102(b) as being unpatentable over Okagaki et al (US Pub. No. 2002/0032876) in view of Ariyoshi (JP Patent No. 403248699) and further in view of BMW2001 (BWM Owner's Manual for Vehicle, Part No. 01410156416, 2000, page 22, Steering Wheel with Multifunction buttons) further in view of Holloway (US Pub. No. 2004/0204192) further in view of Eiche (US Publication No. 2002/0137505) and further in view of Ju (US Publication No. 2005/0015516).

The Examiner rejected Claims 26 and 27 under 35 U.S.C. 102(b) as being unpatentable over Okagaki et al (US Pub. No. 2002/0032876) in view of Ariyoshi (JP Patent No. 403248699) and further in view of BMW2001 (BWM Owner's Manual for Vehicle, Part No. 01410156416, 2000, page 22, Steering Wheel with Multifunction buttons) further in view of Holloway (US Pub. No. 2004/0204192) and further in view of Kashiwamura (US Publication No. 2002/0016188).

The Examiner has repeated the arguments against patentability of the claims as in the previous office action, but has added the further reference of Holloway (US Pub. No. 200410204192).

Holloway discloses an arrangement whereby the standard wireless telephone can still retain all of its desirable light weight and size features while detached from and out of the automobile while still providing user interfaces with a minimum of distraction from driving while the wireless telephone is functionally attached within the automobile. There is a housing adjacent the dashboard for detachably receiving a separable wireless telephone with a display smaller than said dashboard display in combination with switching apparatus for bypassing the wireless telephone display with said dashboard display when said wireless telephone is received in said housing whereby the dashboard display functions as the wireless telephone display. The system may be set so that the switching apparatus automatically bypasses said wireless telephone display when said wireless telephone is inserted into said housing. The standard transceiver in the wireless cellular telephone continues to function normally in receiving and transmitting communications even when the telephone display is bypassed by the dashboard display. This arrangement gives the operator the benefit of having the numerals, text and other elements

presented on the dashboard display enlarged from their normal size on the wireless telephone display.

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 provides: The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929, 933 (Fed. Cir. 1984).

One court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Id. at 1357, 47 USPQ2d at 1458. Here, according to this court, the Board had relied simply upon "the high level of skill in the art to

provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.

Applicant hereby refers to and incorporates the previous arguments in support of patentability.

Regarding the newly cited reference of Holloway, the Examiner is now relying on a combination of 4, 5 and 6 references, which raises the question of teaching, motivation, or suggestion to select and combine the references.

Application of §103 presumes the existence of differences between the subject matter claimed and the teachings of any particular prior art reference. Otherwise a rejection under §102 would have sufficed. Thus, the examiner must propose some modification of a particular reference or a combination thereof with another reference in order to arrive at the claimed invention.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

There must be some logical reason apparent from the evidence of record that would justify a combination or modification of references. In determining whether one of ordinary skill in the art would find it obvious to modify or combine references, the teachings of the references, taken with the knowledge that a worker in the art already possesses, constitute the scope and content of the prior art. Thus, the question raised under §103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art.

Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. Furthermore, when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness cannot be properly made.

In the rejection of the claims of the present application the Examiner attempted to combine a large number of references. Even if, as the Examiner holds, that all of these references are in the same field of endeavor, it is not believe that the Examiner has sufficiently set forth a showing that the resulting combination of these references does not require modifications of the references that destroys the intent, purpose or function of the respective inventions disclosed in the references. It is further believed that only with hindsight would the Examiner attempt to combine the four references.

For example, the Examiner newly cited Holloway, and stated that Holloway teaches a wireless telephone which can be any standard cell phone ([0015], Fig. 2) being used with the hands-free system integrated with a car. The Examiner concluded that it would have been obvious for one of ordinary skill in the art at the time of the invention to combine all the above references' teaching of the hands free integrated system with Holloway's teaching of the mobile phone being removable by the user because this combination would provide more safety in speaking on the phone in the vehicle without having to hold the handset and it is also convenient for being able to carry and use the phone anywhere else.

However, why would one skilled in the art look to Holloway when the Examiner has already stated that Okagaki teaches that the telephone system controls the function of an automotive telephone, so as to enable conversation through a handset and a telephone antenna, via a wireless telephone circuit such as of mobile or cellular phone. One skilled in the art knowing this would have no reason to modify Okagaki so that he could use Holloway.

The dependent claims include all the limitations of the respective independent claims upon which they depend. It has been shown that each of the independent claims, as amended, are not anticipated or obvious in view of any of the cited prior art taken singly or in combination. Therefore, these dependent claims are also allowable over the cited art.

Furthermore it is well accepted that, in going from the prior art to the claimed invention, one cannot base obviousness upon what a person skilled in the art might try or might find obvious to try but rather must consider what the prior art would have led a person skilled in the art to do. One skilled in the art would not have the motivation to combine the cited prior art references. For example, Okagaki et al already provides a microphone and does not suggest that there is any problem with using this microphone. Although Ariyoshi teaches to improve the ratio of an inputted voice to a noise by making the shape of a reflector plate installed so as to be opposed to a microphone in the center of a steering wheel. However, where is the motivation for combining these two references when there appears to be no need for an improved ratio of inputted voice to noise.

The prima facie case of obviousness determination has not been made out. Thus, the opinion of obviousness is deficient and the Applicants are deserving of a patent.

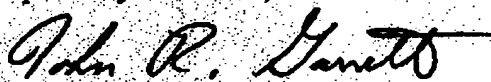
Applicants respectfully submit that the applied references, taken singly or in combination, assuming, arguendo, that the combination of the applied references is proper, do not teach or suggest one or more elements of the claimed invention. Applicants have discussed herein one or more differences between the cited prior art, and the claimed invention with reference to one or more parts of the cited prior art. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of cited prior art correspond to the claimed invention.

Reconsideration and withdrawal of the rejections is therefore respectfully requested. In view of the above remarks, allowance of all claims pending is respectfully requested.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited.

In view of the above amendments and remarks, allowance of all claims pending is respectfully requested. If an additional telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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